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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,213	08/05/2003	David Haffner	GLAUKO.011CP1	6863

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EXAMINER
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DAWSON, GLENN K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/634,213	<b>Applicant(s)</b> HAFFNER ET AL.	
	<b>Examiner</b> Glenn K. Dawson	<b>Art Unit</b> 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 13, 14, 33, 34 and 40-51 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27, 28 and 37 is/are allowed.
- 6) ☒ Claim(s) 5-11, 15-26, 29-32, 35, 36, 38, 39 and 52 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Paraschac, et al.-6050999.

Paraschac discloses a method of treating an eye condition (hyperopia) including the steps of serially dispensing a plurality of preloaded implants 40 from an instrument 50 to a plurality of locations within the eye. In order to dispense the implants at least a portion of the device must move (i.e. the plunger 58,68). Additionally, since the implants would be placed in different locations, the device would inherently need to move to reach these different locations.

Claims 5-7,10,11,13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Poncet-5833694.

Poncet discloses a device having an elongated body 10 housing an inner trocar 22. Inside the body is housed a plurality of biocompatible implants 30. The implants are housed end-to-end. A piston or plunger 81 (actuator) forces the implants out of the

body. The stent implants are capable of transporting fluid therethrough and therefore read on the claim limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-7,13-26,29-31,35,36,38,39 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smedley, et al.-2003/0088260 (or Hill-6533768 in view of Smedley) in view of Poncet-'694, or Paraschac, et al.-'999 or Elliott-6530896.

Smedley discloses the basic instrument and method of use as laid out in the last office action, with the exception of the placing of multiple implants into the body and serially dispensing them into the claimed locations in the eye. However, each of the above references teaches of a dispensing body used to dispense a plurality of implants into a patient's body. Additionally, providing duplicates of known elements has long been determined to be an obvious modification to one skilled in the art. It would have been obvious to have placed several implants into the body of Smedley, as this would allow for the implantation of numerous implants into an eye through the same incision which would allow for faster recovery time and would also allow for a quicker removal of fluid from the eye which is a cause of glaucoma. Smedley also discloses in paragraphs 143 and 144 that the procedure to remove the cataract and implant a trabecular stent can be performed through the same incision.

Hill discloses the device and method as claimed with the exception of the placing of multiple implants into the body and serially dispensing them into the claimed locations in the eye, and the performance of a cataract procedure through the same incision. Smedley discloses a procedure to remove the cataract and implant a trabecular stent can be performed through the same incision. It would have been obvious to have performed a cataract procedure through the same incision as this would allow for the

replacement of the natural lens with an IOL and the relieving of intraocular pressure with the stent, all of which being performed through one incision speeds recovery.

***Allowable Subject Matter***

Claims 27,28 and 37 are allowed.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 07-18-2006 have been fully considered but they are not persuasive.

The examiner contends that since Smedley discloses the placement of the outlets in different locations, including collecting channels, that one skilled in the art would recognize that in an eye having dangerous internal pressures, that given the different disclosed locations for placement of the stent, that the mere duplication of the dispensing steps to implant a second stent into a secondary location would merely increase the rate of outflow and bring the internal fluid pressure under control much more quickly.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Glenn K Dawson  
Primary Examiner  
Art Unit 3731

Gkd  
20 September 2006